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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/627,018	07/27/2000	Helmut Weber	70442.1201	9975

7590 04/30/2004  
Peter A Sullivan  
Ronald Abramson  
Hughes Hubbard & Reed LLP  
One Battery Park Plaza  
New York, NY 10004

EXAMINER

THALER, MICHAEL H

ART UNIT PAPER NUMBER

3731

DATE MAILED: 04/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 09/627,018	<b>Applicant(s)</b> WEBER ET AL.	
	<b>Examiner</b> Michael Thaler	<b>Art Unit</b> 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on 10 March 2004.
- 2a)  This action is **FINAL**.                      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4)  Claim(s) 1-8 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1-8 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \*    c)  None of:
1.  Certified copies of the priority documents have been received.
  2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

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**Attachment(s)**

- |   |  |
|---|--|
| <p>1) <input type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br/>Paper No(s)/Mail Date _____.</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413)<br/>Paper No(s)/Mail Date. _____.</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6) <input type="checkbox"/> Other: _____.</p> |
|---|--|

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The disclosure is objected to because of the following informalities: The amendment to the paragraph of col. 1, lines 9-14 is incorrect since "Rongeurs" is not underlined. Appropriate correction is required.

The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because it fails to identify the citizenship as well as the residence and mailing address of inventor Gernot Weber as required by 37 CFR 1.63 (a)(3) and (c).

Claims 1-8 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175. The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

Claim 8 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Falk (4,994,024). Falk discloses a convertible rongeur (The Falk instrument is a rongeur since it cuts cartilage and bone as described in col. 1, lines 34-37.) comprising front handle piece 10, bottom shaft piece 4, 3, 5, 1a (which is bottom since it is generally below the top shaft cutting piece 11, 9) having tip portion (the distal portion of jaw 4 which has a reduced height as compared with the proximal portion as seen in figure 2) and handle portion 1a, top shaft cutting piece 11, 9

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slideably engaged with the tip portion (Portion 11 of the top shaft cutting piece 11, 9 is slideably engaged with the sides of the tip portion as jaw portion 11 opens and closes since figure 3 shows jaw portion 11 contacting the sides of the tip portion at 4.), the top shaft cutting piece being disengageable with the tip portion (when the jaw is completely open as shown in figure 2) wherein, when the top shaft cutting piece is disengaged from the tip portion, the top shaft cutting piece remains attached to the rongeur so as to retain all parts of the rongeur in one attached unit. Alternatively, it would have been obvious that portion 11 of the top shaft cutting piece 11, 9 is slideably engaged with the sides of the tip portion as jaw portion 11 opens and closes since figure 3 shows jaw portion 11 contacting the sides of the tip portion at 4. Alternatively, member 11 alone may be considered to be the claimed top shaft cutting piece.

Claims 1-7 are free of any rejection based upon the prior art of record.

Applicant's arguments filed March 10, 2004 have been fully considered but they are not persuasive. Contrary to applicant's remarks no substitute declaration is present in the file. The portion 11 of the Falk top shaft cutting piece 11, 9 is slideably engaged with the sides of the tip portion as jaw

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portion 11 pivots open and closed as broadly claimed. Pivoting motion is not inconsistent with sliding motion.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (703) 308-2981. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Milano can be reached on (703)308-2496. The fax phone number for the

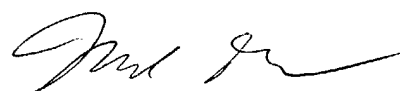
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organization where this application or proceeding is assigned is  
(703)872-9306.

Any inquiry of a general nature or relating to the status  
of this application or proceeding should be directed to the  
receptionist whose telephone number is (703)308-0858.

mht  
4/26/04



MICHAEL THALER  
PRIMARY EXAMINER  
ART UNIT 3731